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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
13/156,260	06/08/2011	Franz-Josef Lenze	508637	4650

53609 7590 04/07/2017

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ART UNIT	PAPER NUMBER
1734	

NOTIFICATION DATE	DELIVERY MODE
04/07/2017	ELECTRONIC

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte FRANZ-JOSEF LENZE, SASCHA SIKORA, and JANKO BANIK

Appeal 2016-000312
Application 13/156,260
Technology Center 1700

Before ADRIENE LEPIANE HANLON, BRIAN D. RANGE, and LILAN REN, *Administrative Patent Judges*.

RANGE, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING

This decision responds to Appellants' March 17, 2016, Request for rehearing (hereinafter, the "Request") of our Decision mailed January 18, 2016 (hereinafter, the "Decision").

Appellants correctly argue that claims 1–**10** and 15–25 were subject to appeal. Request 2. The Decision erroneously refers to claims 1–9 and 15–25 (Decision 1) being on appeal and affirms the Examiner's rejection with respect to these same claims (*id.* at 1, 7). The error appears to have resulted from reference to the Office Action Summary for the Examiner's September 4, 2014, Final Rejection which erroneously states that claims 1–9 and 15–25

are rejected and that claims 10–14 are withdrawn from consideration. Review of the Appellants' November 14, 2014, claim amendments confirms that only claims 11–14 were withdrawn, and Appellants correctly stated the status of the claims in the Appeal Brief. Appeal Br. 2.

Claim 10 recites the "[m]ethod according to claim 1, wherein the component is a body part or a chassis of a motor vehicle." Appeal Br. 12 (Claims App'x). Appellants argue that this recitation renders claim 10 allowable. Request 2. In the Appeal Brief and Reply Brief, however, Appellants made no arguments regarding the recitations of claim 10. Rather, Appellants only substantively argued the limitations of claim 1. Appellants therefore waived any arguments relating to the particular recitations of claim 10. *See Ex parte Frye*, 94 USPQ2d 1072, 1075 (BPAI 2010) (precedential) (cited with approval in *In re Jung*, 637 F.3d 1356, 1365 (Fed. Cir. 2011) ("it has long been the Board's practice to require an applicant to identify the alleged error in the examiner's rejections")); *In re Chapman*, 595 F.3d 1330, 1338 (Fed. Cir. 2010), *quoting Shinseki v. Sanders*, 556 U.S. 396, 409 (2009) ("the burden of showing that an error is harmful normally falls upon the party attacking the agency's determination."). Because of this waiver, the Decision appropriately treated all claims as a group consistent with the provisions of 37 C.F.R. § 41.37(c)(1)(iv) (2015). Decision 3 ("all other claims on appeal stand or fall together with claim 1").

Except for particular circumstances that do not apply here, arguments not previously raised are not permitted in a request for rehearing. 37 C.F.R. § 41.52(a)(1). We therefore decline to consider Appellants' new arguments regarding the recitations of claim 10 at this time.

Appellants also argue that the Decision's statement that "[c]laim 1 is not limited based upon the material worked on" would indicate, as stated by Appellants, "that a limitation in this regard would render claim 1 allowable." Request 2 (quoting Decision 6). The statement does not provide such an indication. Rather, our duty in this appeal is solely to review the adverse decision of the Examiner upon Appellants' written appeal. 35 U.S.C. § 6(b)(1).

For the above reasons, we clarify the Decision as affirming the Examiner's rejection of claims 1–10 and 15–25. The Request, however, is denied in that we decline to address patentability arguments raised for the first time in the Request.

DENIED